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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,336	05/11/2001	Colin Hendrick	64482	7643

7590 10/18/2004  
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EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/854,336

**Applicant(s)**

HENDRICK, COLIN

**Examiner**

Allyson N Trail

**Art Unit**

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Amendment***

1. Receipt is acknowledged of the Amendment filed August 23, 2004.

### ***Remarks***

2. The previous office action dated March 25, 2004 included a final rejection of claims 1-28. Claims 1, 3-8, 11, 13-18, and 28 were rejected under 35 U.S.C. 102(e) and claims 2 and 12 were rejected under 35 U.S.C. 103(a).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 11, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by McNabb et al (6,289,462).

McNabb et al teaches the following in regards to claims 1, 11, and 28:

“This invention generally relates to computer systems security, and operating system design where the access, control, rights and privileges are assigned to the individual file members and not strictly to the user or process that accesses the computer.” (Col. 1, lines 11-15).

“For Internet-based transaction systems, the security mechanisms must be able to provide or deny access to particular web pages, applications, and databases on the basis of individual user profiles.” (Col. 3, lines 21-24).

“The authentication module 9 of the trusted server system can be configured to request a user to provide a user ID and a site-definable authentication response (such as a password, a biometric device, a smart card, or an access token check) prior to permitting access. Once the user has been authenticated, subsequent web requests can be identified by the UDE as part of an authenticated session, and communication to other restricted partitions can be allowed.” (Col. 15, lines 54-61). Although a reader is not specifically disclosed, in order for the smart card (discussed above) to communicate with the authentication module, there must be a reader.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNabb et al (6,289,462) in view of Etheredge (6,172,674).

McNabb et al's teachings are discussed above. McNabb et al fails to teach the digital content including one of the following: e-books, e-magazines, e-newsletters, software, games, digital music, or digital video.

The Etheredge reference teaches accessing television program information via a network.

Regarding claims 2 and 12, Etheredge teaches the following:

“Client computer 100 is also connected to a communication system 106. In one embodiment, communication system 106 includes a telephone network and the Internet. In other embodiments, communication system 106 could include a network, the Internet without a telephone network, a dedicated communication system, a single connection to another computer or any other means for communicating with another electronic entity.” (Col. 3, lines 29-36).

“Smart card reader 160 is used to read a smart card. In one embodiment, client computer 100 is a network computer and the smart card is a non-volatile memory device, approximately the size of a credit card, used to store information about a user and services utilized by that user. By plugging the smart card into smart card reader 160, client computer 100 is configured to operate with the user's configurations and allows the user to access services via communication system 106.” (Col. 4, lines 55-63).

“One feature of the network computer of FIG. 2 is that it does not contain disk drives. Thus, the first time client computer 100 is powered on with the intention to use the electronic program guide of the current invention, client computer 100 downloads electronic program guide software from near side server 108. After downloading the software to operate the electronic program guide, client computer 100 downloads television programming information.” (Col. 4, line 65 – Col. 5, line 6).

In view of Etheredge's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to include, in addition to user approved access onto a specific Internet site, users being approved for downloading content from that site. Both McNabb et al and Etheredge teach using a smart card to gain access to various information. One would be motivated to not only protect access to a web page, but also to guard against unauthorized users downloading digital content.

7. Claims 3-7, 9, 10, 13-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNabb et al (6,289,462) in view of Tolopka et al (6,044,349).

McNabb et al's teachings are discussed above (including teachings in regards to claims 5-7, and 15-17, specifically including the data card containing access rights information and usage right information, authorizing a user following a match of the information stored on the data card and information inputted by the user, and further usage rights information including read-only rights). McNabb et al fails to specifically teach inputting personal identification information for encryption and storage on the data card.

Regarding claims 3, 4, 13, and 14, Tolopka et al teach the following:

"Smart cards have also been used to increase computer security. Generally, when a computer is remotely accessed over an insecure network, password keystrokes are vulnerable to detection. With a smart card, however, a computer password can be encrypted and stored in the card's memory. Then, from any remote terminal that has a

smart card reader, access to a central computer can be established using an encrypted password.” (Col. 1, lines 53-60).

“Smart card 120 also allows a user to conveniently select the information to disseminate. For example, FIG. 2 shows one embodiment of how information can be stored and organized in smart card 120. As shown, a number of information units have been stored on the smart card. The information units include the user's name 205, electronic signature 215, home address 225, unlisted phone number 235, and credit card number 245, as well as two location key pairs 255 and 265.” (Col. 3, line 66 – Col. 4, line 7).

Regarding claims 9, 10, 19, and 20 Tolopka et al teach the following:

“Banks have typically marketed smart cards as secure cash replacements, wherein a user downloads a balance of money into the card's memory. The user can make purchases, from anyone who has a smart card reader, by debiting the balance stored in the card's memory.” (Col. 1, lines 32-37).

In view of Tolopka et al's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to input personal identification information including a user name onto the data card taught above by McNabb et al. McNabb et al teach using a data card to provide access to an Internet site. Although it is not specifically disclosed, it is both obvious and necessary to include user information on the data card in order to permit user access onto an Internet site. Additionally, one would be motivated for the data card to keep track of an account balance. The data card provides user access to various member only websites. One would be motivated

to include a payment system and up to date account balances in order to purchase software or download music from the accessed web page.

8. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNabb et al (6,289,462) in view of Kashef et al (2002/0175207).

McNabb et al's teachings are discussed above. McNabb et al fails to teach tracking subsequent use of the digital content by the user.

Regarding claims 8 and 18, Kashef et al teach the following:

"In today's technologically advanced society, businesses often issue cards to consumers for making transactions and so that their purchases and other transactions may be tracked. For example, many businesses currently make use of so-called "loyalty" programs that reward customers for frequent purchase of the business's products or services." "Still other loyalty programs have been implemented using a smart card in conjunction with a terminal at a loyalty operator's place of business."

(Page 1, paragraph 0003).

"Although terminal applications cannot easily be altered to be compatible with different terminals, the number and capability of terminals are expanding. In addition to electronic point of sale systems, EFT/POS terminals and ATMs, non-traditional points of interaction require card acceptance in kiosks, personal computers, network computers and consumer appliances such as smart phones, television set-top boxes and advanced electronic game systems." (Page 1, paragraph 0011).

In view of Kashef et al's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to include the ability to track



user's digital content use on the application program located on the data card. The data card disclosed by McNabb et al includes user information in order to permit access to various types of digital content. One would be motivated to include a tracking system as taught by Kashef et al in order to reward a user with free digital content.

9. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over McNabb et al (6,289,462) in combination with Tolopka et al (6,044,349) and in further view of Kashef et al (2002/0175207).

McNabb et al's teachings in combination with the teachings of Tolopka et al are discussed above. The combination of the teachings however fails to teach tracking subsequent use of the digital content by the user.

Kashef et al's teachings are also discussed above.

In view of Kashef et al's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to include the ability to track user's digital content use on the application program located on the data card. The data card disclosed by the combination of McNabb et al and Tolopka et al includes user information needed in order to permit access to various types of digital content, wherein the user inputs identification information onto the data card. One would be motivated to include in the data card system taught by the combination of McNabb et al and Tolopka et al, a tracking system as taught by Kashef et al in order to reward a user with free digital content. The reward is provided as an incentive for the user to access and purchase more digital content.

10. Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over McNabb et al (6,289,462) in combination with Tolopka et al (6,044,349) and Kashef et al (2002/0175207) and in further view of Etheredge (6,172,674).

McNabb et al's teachings in combination with the teachings of Tolopka et al and Kashef et al are discussed above. McNabb et al's teachings above specifically include teachings in regards to claims 25-27, including the data card containing access rights information and usage right information, authorizing a user following a match of the information stored on the data card and information inputted by the user, and further usage rights information including read-only rights. The combination of the teachings however fails to specifically teach the digital content including at least one of e-books, e-magazines, e-newsletters, software, games, digital music, and digital video.

Etheredge's teachings are discussed above.

In view of Etheredge's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to include, user approved access to digital content via use of a user inputted data card, including a tracking system, wherein the digital content includes e-books, etc. (as taught by Etheredge). Although McNabb et al in combination with Tolopka et al and Kashef et al does not specifically teach the digital content being in the form of e-books, one would be motivated include e-books as a form of digital content in order to not only guard against viewing a web page as taught by McNabb et al, but also guard against unauthorized access to other forms of digital content such as e-books.

***Response to Arguments***

11. Applicant's arguments, see remarks, filed August 28, 2004 with respect to the teachings of Craig et al have been fully considered and are persuasive. The final rejection of claims of 1-28 has been withdrawn. The Examiner agrees with the Applicant's arguments in regards to the teachings of Craig et al and what the reference fails to teach. Craig et al does not show or suggest digital rights information specific to the user. Therefore an additional reference (McNabb et al) has been added that teaches a system for managing digital rights of digital content over a network.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Usui (5,956,697), DiGiorgio et al (6,385,729), Tello (6,463,537), Fox et al (2002/0002477), Wecker et al (6,256,614), and Kolls (2002/0077889).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[allyson.trail@uspto.gov](mailto:allyson.trail@uspto.gov)].

Art Unit: 2876

*All Internet e-mail communications will be made of record in the application file.*

*PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Allyson N. Trail  
Patent Examiner  
Art Unit 2876  
September 30, 2004

*Jared J. Furman*  
**JARED J. FUREMAN**  
**PRIMARY EXAMINER**